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REMARKS

This application has been carefully reviewed in light of the Office Action dated November 6, 2006. Claims 1-9 remain pending in this application. Claim 1 is the independent claim. Claims 1-9 have been amended to remove the reference numerals. No new matter has been added. Favorable reconsideration is respectfully requested.

On the merits, the Office Action objected to the specification because of the lack of the preferred layout for the specification and for referencing the claims in the disclosure. In addition, the Office Action provisionally rejected Claims 1-3 and 5-9 under 35 U.S.C. §101 as claiming the same invention as that of Claims 1-7 of copending Application No. 10/524,075. The Office Action also rejected Claims 1-9 under 35 U.S.C. §103(a) as being unpatentable over Magnus et al. (U.S. Patent No. 2,423,245; hereinafter "Magnus") in view of Bosland (U.S. Patent No. 3,802,309; hereinafter "Bosland"). Applicants respectfully traverse the above rejections for at least the following reasons.

The Examiner objected to the disclosure because the specification fails to disclose section headings including Background, Summary of the Invention, Brief Description of the Drawings, and Detailed Description of the Invention. In response to the Examiner's objection to the specification for failing to provide header sections, Applicants gratefully acknowledge the suggestion, but respectfully decline to add the headings as they are guidelines and not required in accordance with MPEP §608.01(a). With respect to referencing claims in the disclosure, Applicants have amended the specification to remove the specific references to the claims.

With respect to the Examiner's provisional double patenting rejection with respect to Application No. 10/524,075, Applicants shall take action when the claims of Application No. 10/524,075 issue.

In order to combine references for an obviousness rejection, there must be some teaching,

suggestion or incentive supporting the combination. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1399 (Fed. Cir. 1989). The fact that a prior art device could be modified so as to produce the claimed invention is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification. *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). In addition, it is also improper to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). Furthermore, in order to make obvious Applicants' claimed invention, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 480 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

The Examiner rejected Claim 1 under 35 U.S.C. §103(a) as being unpatentable over Magnus in view of Bosland. Bosland discloses a tape dispenser not for use in hair removal. Magnus discloses a hair removal device that removes hair by pulling "the device quickly in a manner similar to the operation of a pair of tweezers." See Magnus column 3, lines 47-50. But Magnus in view of Bosland does not recite, suggest, teach, or render obvious all of the claim elements of Applicants' Claim 1. For instance, Magnus in view of Bosland does not disclose a depilating apparatus including a "determination means for determining the application length along which the depilating tape adheres to the skin of a person" and "wherein the determination means are designed to determine different application lengths as desired," as recited in Applicants' Claim 1. Magnus does not teach or recite determining the application length along which the depilating tape adheres to the skin where such lengths are determined as desired by the user of the device through the determination means. In the device of Magnus, said application length is fixed and determined by the distance between ends 8 of spring blades 9 and 10. See Magnus column 3, lines 18-50 and Figures 2 & 4. This is because the spring blades 9 and 10 apply

pressure to hair 37 so that a "quick pull of the device will extract these hairs." *See Magnus* column 4, lines 17-20 & 68-71. Therefore, the device in *Magnus* does suggest, recite, or teach "determining the application length along which the depilating tape adheres to the skin of a person." Furthermore, the application of the tape in *Magnus* has no effect on the application length and in fact tape "devoid of adhesive" may be used to remove hair given the tweezer-like pulling action required to remove hair using the *Magnus* device. *See Magnus* column 4, lines 5-20. In addition, *Bosland* does not suggest, recite, or teach "determination means for determining the application length along which the depilating tape adheres to the skin of a person." Hence *Magnus* in view of *Bosland* does not provide for determination means for determining the application length along which the depilating tape adheres to the skin as recited by Applicants' Claim 1. Therefore, *Magnus* in view of *Bosland* does not recite, suggest, teach, or render obvious all of the claim elements in Applicants' Claim 1.

In addition, the Examiner has stated that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the knob, which operates the wind-up reel of *Magnus et al.* reference, with the motor of *Bosland* reference for ease and efficiency of operation." *See Office Action* 11/6/2006, Page 5-6. If the Examiner is indeed relying on the general knowledge of one of ordinary skill in the art in combining the hair removal device of *Magnus* with tape dispenser not for use in hair removal of *Bosland*, then the Examiner has failed to properly support such reliance. In instances where the general knowledge of one of ordinary skill in the art is asserted, "that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review." *See In Re Sang Su Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002). Therefore, the rejection of Claims 1-9 is improper and the Applicants respectfully request that the Examiner reexamine, reconsider, withdraw the rejection to and allow Claims 1-9.

Claims 2-9 depend from independent Claim 1 as discussed above and are therefore believed patentable for at least the same reasons. Applicants further believe the §103(a) rejections of Claims 2-9 to be moot in light of the above remarks and request their withdrawal.

In view of the foregoing amendments and remarks, Applicants respectfully submit that the currently pending claims are clearly patentably distinguishable over the cited and applied references. Accordingly, entry of this amendment, reconsideration of the rejections of the claims over the references cited, and allowance of this application is earnestly solicited.

Respectfully submitted,

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